UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,232	08/20/2003	Paul E. Jacobs	000373D2	7151

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA   92121-1714

EXAMINER
ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/645,232	JACOBS ET AL.
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 August 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-21 are presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.   Claims 1-21 are provisionally rejected under the judicially created doctrine

of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113,

126-127, 136-137 and 146 of copending Application No.09/679,039. Although the

conflicting claims are not identical, they are not patentably distinct from each other

because the co-pending application further recites transmitting ad-statistical data.

Calculating and transmitting statistical data it is old and well known in business in order

to calculate and transmit statistical data in order to make educated assumptions and

statements on a particular subject. It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to have included transmitting ad-

statistical data in order to achieve the above mentioned advantage.

3.   Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites an ad link history display window that lists links to the sources of advertisements that the user has previously visited. Listing the sources of advertisements or information that the user has previously visited it is old and well known in order to keep track of the success of the different sources of advertisements. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included a display window that lists links to the sources of advertisements that the user has previously visited in order to achieve the above mentioned advantage.

4.   Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application further recites that the advertisement download communication link and the data communication link are separate communication links. It is old and well known in the communication and networking arts to have various communication links because such a modification would allow for easier transmission of data. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have link are separate communication links in order to achieve the above mentioned advantage.

5.   Claims 1-21 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-18 and 51-53

of copending Application No.09/668,553. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the co-pending

application further recites transmitting ad obscured ad monitor function that determines

whether an obscured ad condition has occurred, whereby the obscured ad condition

occurs when an advertisement current being displayed on the display associated with

the client device is being obscured by one or more other items currently being displayed

on the display and an obscured nag function that generates an obscured ad nag display

in response to detection of the obscured ad condition, wherein the obscured nag display

notifies the user of the obscured ad condition. Since, monitoring and displaying various

advertisements which can occupy the entire portion of the display along with banner

advertisements is obvious in on-line advertisements then it would have been obvious to

a person of ordinary skill in the art at the time of Applicant's invention to have included

detecting if a displayed advertisement such as a banner advertisements is being

obscured by an advertisement and notifying the user in order for the user to be aware

that might not be compensated for viewing the banner advertisements that is being

obscured by the advertisement.

6.   Claims 1-21 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 18-33, 59 and 62

of copending Application No.09/668,331. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the co-pending

application further recites a playlist that identifies the advertisements to be downloaded.
Identifying or selecting the advertisements to be downloaded is obvious and well known
in order to provide some sort of order within the system. It would have been obvious to
a person of ordinary skill in the art at the time of Applicant's invention to have included
transmitting ad-statistical data in order to achieve the above mentioned advantage.

7.   Claims 1-21 are provisionally rejected under the judicially created doctrine of
obviousness-type double patenting as being unpatentable over claims 46-70 and 74-76
of copending Application No.09/668,632 Although the conflicting claims are not
identical, they are not patentably distinct from each other because the co-pending
application further recites an e-mail function for receiving and sending e-mail to other
client devices. Sending and receiving e-mail to other clients is old and well known in the
computer related arts in order to receive messages immediately from other clients . It
would have been obvious to a person of ordinary skill in the art at the time of Applicant's
invention to have included receiving and sending e-mail messages in order to achieve
the above mentioned advantage.

8.   . Claims 1-21 are provisionally rejected under the judicially created doctrine of
obviousness-type double patenting as being unpatentable over claims 36-70, 74-76 and
78 of copending Application No.09/668,515.Although the conflicting claims are not
identical, they are not patentably distinct from each other because the present
application further recites three operating modes. Different operating modes such as
Online and offline operating modes are known in the computer related arts in order to
provide different states of the program.   It would have been obvious to a person of

ordinary skill in the art at the time of Applicant's invention to have included receiving and

sending e-mail messages in order to achieve the above mentioned advantage.

9.   Claims 1-21 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1,9-11,14-

24,43,45-54,77-79,81,82,84,86-92,94,95,97-105,107-109 and 111 of copending

Application No.09/668,631. Although the conflicting claims are not identical, they are

not patentably distinct from each other because the co-pending application further

recites a playlist that identifies the advertisements to be downloaded. Identifying or

selecting the advertisements to be downloaded is obvious and well known in order to

provide some sort of order within the system. It would have been obvious to a person of

ordinary skill in the art at the time of Applicant's invention to have included transmitting

ad-statistical data in order to achieve the above mentioned advantage.

10.   Claims 1-21 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 1-53 of

copending Application No.09/668,600. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the instant application further

recites a third operating mode in which the software switches the operating from a first

operating mode to a second operating mode, wherein the second operating mode has

less features than the first operating mode. Official notice is taken that it is old and well

known in the computer related arts to switch from one operating mode to another

operating mode that has less features when a problem arises with one of the operating

mode because such a modification would allow the software to operate with less

features and in that case less problems are less likely to occur. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included switching from a first operating mode to a second operating mode, wherein the second operating mode has less features than the first operating mode in order to obtain the above mentioned advantage.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11.   Claims 1-18 and 51-53 are rejected under 35 U.S.C. 101 because the claims are recite functional descriptive material (software/program per se).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh) in view of Montague (6,298,332 hereinafter Montague).

With respect to claims 1, 4, 7, 8, 10, 15-17 Marsh teaches software for use on a client device that is configured for communications with at least one remote source of

advertisements via a communications network (Abstract). An advertisement download

function that downloads advertisements from at least one remote source, during one or

more advertisements download sessions (see figure 4,

item 601); an advertisement store function that stores the download

advertisements on a storage medium associated with the client device (col. 14, lines 1-

10); an advertisement display function that effects display of at least selected ones of

the stored advertisements on a display associated with the client device (Figure 6, 702);

an audit function that compiles as-related statistical data relating to the downloaded

advertisements, wherein the ad-related statistical data includes display event-related

data regarding advertisements that were displayed during a prescribed audit interval

(col. 14, lines 66-, col. 15, lines 1-7); an audit data transmit function that transmits the

ad-related statistical data to a prescribed server system (Figure 8 and col. 15, lines 10-

20).

Marsh teaches sending the statistical data to the server (Figure 8 and col. 14,

lines 66-, col. 15, lines 1-20). Marsh does not specifically teach sending the data only in

response to a user's grant permission to do so. Montague teaches delivering vendor-

supplied information to a purchase, while the purchaser authorizing transmission of

various data to a vendor server or a third party server (col. 9, lines 20-24). It would

have been obvious to a person of ordinary skill in the art at the time of Applicant's

invention to have included in the system of Marsh the teaching of Montague of sending

the data only in response to a user's grant permission to do so because such a

modification would allow the users to have controlled of the data that is transmitted.

With respect to claims 2-3 , Marsh further teaches that the prescribed rollover

intervals correspond to the prescribed audit intervals (col. 3, lines 12-27 and col. 7, lines

7-24).

With respect to claim 5, Marsh further teaches under a client policy transmitting a

statistical sampling of a population of client devices, at prescribed times (col. 3, lines 12-

27 and col. 7, lines 7-24).

Claim 6 further recites transmitting to random ones of population of client devices

at prescribed times.   Official notice is taken that it is old and well known to perform a

function at random in order to protect the data been transmitted. It would have been

obvious to a person of ordinary skill in the art at the time of Applicant's invention to have

included transmitting the audit at random times in order to obtain the above mentioned

advantage.

With respect to claim 9, Marsh further teaches clickthrough data regarding each

advertisement that was clicked on by the user during the prescribed audit interval (col.

15, lines 14-20).

With respect to claim 11, Marsh further teaches that the advertisement distribution server system is managed by a producer of the software (col. 3, lines 12-56).

With respect to claim 12, Marsh further teaches that the advertisement distribution server system is managed by a distributor of the software (col. 3, lines 12-56).

With respect to claim 13, Marsh further teaches that the communication network is the Internet (Figure 8, 107).

With respect to claim 14, Marsh further teaches that the software is e-mail software (see Figure 8).

With respect to claim 18, Marsh further teaches that advertisement display function effects display when the client device is offline (col. 6, lines 63-, col. 7, lines 1).

With respect to claim 19, Marsh further teaches that the advertisement display function effects display while the user is composing/reading e-mail messages (col. 7, lines 1-6).

Claims 20-21 further recite that the audit data is transmitted at activated random times. Marsh teaches transmitting audit data (col. 14, lines 66-, col. 15, lines 1-7).
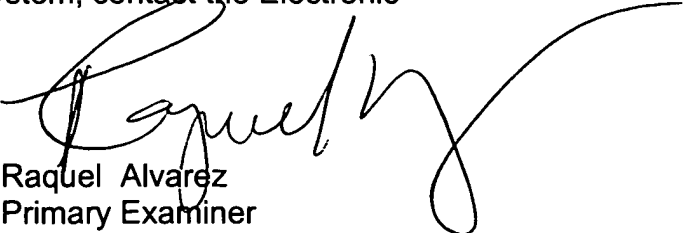
Marsh does not specifically teach transmitting the audit data at random times. Official

notice is taken that it is old and well known to perform a function at random in order to

protect the data been transmitted. It would have been obvious to a person of ordinary

skill in the art at the time of Applicant's invention to have included transmitting the audit

at random times in order to obtain the above mentioned advantage.

Point of contact

13.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Raquel Alvarez whose telephone number is (703)305-

0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
10/13/04